

REMARKS

The present amendment is responsive to the Official Action mailed August 3, 2009. A petition for a two-month extension of the term for response to said Official Action, to and including January 3, 2010, is transmitted herewith. As January 3, 2010 is a Sunday, the present reply is timely filed with a certificate of transmission dated January 4, 2010.

Claims 7-9 and 19-21 are pending, with claims 7 and 19 being independent. Claim 7 has been amended herein. No new matter is presented by this amendment.

In the Official Action, the Examiner rejected claims 7-9 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,374,270 to McGuire *et al.* ("*McGuire*") in view of German publication number DE 3800482 to List ("*List*"). Additionally, claims 19-21 were rejected under 35 U.S.C. § 103(a) as being obvious over *McGuire* in view of *List* and further in view of U.S. Patent No. 3,216,288 to Gardner ("*Gardner*").

McGuire discloses a drill bit 11 for inserting a guide pin 12 into tissue. The drill bit 11 includes a longitudinal cannula 17 for receiving the guide pin 12. Once the guide pin 12 is received in the cannula 17 of the drill bit 11, the drill bit 11 and guide pin 12 are locked together, thus preventing the now claimed "sliding movement" during boring. In this regard, the shank 14 of the drill bit 11 includes one or more longitudinal slots 16 that permit the shank 14 to compress inwardly to grip the guide pin 12 when the drill bit 11 is secured in a drill chuck. (See *McGuire* col.3 ll.25-34.) In one embodiment, the distal tip 72 of the guide pin 12 may be shaped to engage the tip 15 of the drill bit 11 (as shown in FIGS. 6-7) to prevent the pin 12 from moving axially into the drill bit 11 towards the drill. (See *id.* col.4 ll.26-34.) After the bit-guide combination is drilled into the tissue, the drill

bit 11 is then removed from the guide pin 12, leaving the guide pin 12 embedded in the tissue. (See *id.* col.4 ll.52-53.)

List discloses a surgical drilling instrument having depth marks 4 on the shaft 3 of the drill. A sleeve 5 surrounds the drill and includes a window to permit viewing of the depth marks 4 (as shown in FIG. 2).

In the Official Action, the Examiner contended that *McGuire* discloses all of the features recited in claim 7 except for the "elongated opening" through the wall of the boring tool for viewing the trailing end of the guide wire. (See Official Action 2.) The Examiner identified *List* as a teaching of "a window in the shank of the device" and contended that, in view of *List*, it would have been obvious to include a window in the shank of *McGuire*. (See *id.*) However, the Examiner's rejection is respectfully traversed.

First of all, the window disclosed in *List* is not "in the shank" of the drill, as was stated by the Examiner, but instead is in the sleeve 5 surrounding the drill. As discussed above, the window in the sleeve 5 provides a view of the depth marks 4 on the outside of the drill shaft 3 in order to determine the depth of the drill. *McGuire* does not teach using such a sleeve for guiding its drill bit 11. Moreover, even if a sleeve were provided with the drill of *McGuire*, based on the teachings of *List*, the combination would still fail to meet the feature of claim 7 reciting "an elongated opening" through the wall of the boring tool "for viewing said guide wire trailing end." That is, as taught by *List*, the window in the sleeve would permit a view of the exterior of *McGuire*'s drill bit 11 in order to monitor the depth of the bit 11. The window would not permit a view of the guide pin 12 of *McGuire* (contended "guide wire") during the boring operation because the pin 12 is inside and surrounded by the bit 11, and there is no teaching or suggestion in either of the references to provide an opening in

a rotatable drill bit in order to view a guide pin located therein.

Furthermore, it would not be obvious to provide such an "opening" in the drill bit 11 of *McGuire*. In the Official Action, the Examiner contended that "[h]aving a window in the shank of the tool would allow for the surgeon to see how far the guide wire has advanced within the device." (Official Action 2.) However, this reasoning does not make sense because, as discussed above, the guide pin 12 of *McGuire* (contended "guide wire") is locked to the drill bit 11 during insertion, and the two components do not move with respect to one another. Therefore, the guide pin 12 will have the same depth as the drill bit 11, and a window in the drill bit 11 to view the guide pin 12 would serve no purpose.

Thus, in view of the above, it is respectfully requested that the rejection of independent claim 7 be withdrawn. Additionally, due at least to the dependency of claim 8 and 9 from independent claim 7, the rejection of such dependent claims should likewise be withdrawn.

Independent claim 19 recites, *inter alia*, that the shank of the rotatable cutting tool has "a pair of diametrically opposed windows therein," with the trailing end of a guide wire being "viewable through the windows in the shank." The Examiner rejected claim 19 similarly to independent claim 7, contending that *McGuire* in view of *List* teaches the claimed invention except for the "slideable lock portion," which the Examiner contended is taught by *Gardner*. However, *Gardner* was not relied on by the Examiner as teaching anything which would remedy the deficiencies of *McGuire* and *List* pointed out above. Therefore, the rejection of independent claim 19, and claims 20-21 depending therefrom, should be withdrawn for the same reasons discussed above with respect to claim 7.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: January 4, 2010

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